

REMARKS

I. Introduction

Pending claims 1-19 have been examined and claims 2-4, 6-10, 11/6-10, 12/6-10, 13/6-10, 14/6-10, 15/6-10, 16/7-8, 17/7-8, 18/7-8, and 19/6-10 are allowed. Furthermore, Applicants thank the Examiner for acknowledging that claims 11/5, 13/5, 14/5, 15/5 and 19/5 contain allowable subject matter.

However, the Examiner rejects claims 1, 5 and 12/5. Specifically, claims 1, 5 and 12/5 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hayashi, U.S. Patent No. 6,070,096 (hereinafter "Hayashi") in view of Graessle et al., U.S. Patent No. 5,334,841 (hereinafter "Graessle") and Cline et al., U.S. Patent No. 6,462,770 (hereinafter "Cline").

Applicants traverse the rejection of claims 1, 5 and 12/5 as follows.

II. Allowable Subject Matter

As noted above, claims 2-4, 6-10, 11/6-10, 12/6-10, 13/6-10, 14/6-10, 15/6-10, 16/7-8, 17/7-8, 18/7-8, and 19/6-10 are allowed. Furthermore, while the Examiner acknowledges that claims 11/5, 13/5, 14/5, 15/5 and 19/5 contain allowable subject matter, the Examiner objects to these claims as being dependent on a rejected base claim. However, the Examiner indicates that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Because Applicants traverse the rejection of claims 1, 5 and 12/5 as follows, objected to claims 11/5, 13/5, 14/5, 15/5 and 19/5 are allowable at least by virtue of their dependency.

III. Claim Rejections -- 35 U.S.C. § 103(a)

Claims 1, 5 and 12/5 stand rejected under § 103(a) as allegedly being unpatentable over Hayashi in view of Graessle and Cline.

Claims 1 and 5

The Examiner relies on the endoscope system illustrated in Fig. 6 of Hayashi as teaching most of the steps recited in claim 1 (*see also* the structural elements of claim 5).

The Examiner acknowledges that Hayashi fails to teach or suggest "detecting that an operational irregularity has occurred in the excitation light emitting means", as recited in claim 1 (*see also* claim 5).

The Examiner alleges that those of ordinary skill in the art of detecting fluorescence know from Graessle that verification of the energy source which excites the target material is important (Graessle: col. 4, lines 60-65). Consequently, the Examiner alleges that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method disclosed by Hayashi to further include a step of detecting that an operational irregularity had occurred in the excitation light emitting means" (Office Action: page 3).

The Examiner acknowledges that Graessle only describes the providing of an alarm in the event that the energy source is not operational. However, the Examiner alleges that Cline discloses that "the image obtaining portion for the fluorescent light image must be protected when not in use obtaining a fluorescent light image" (Cline: col. 11, lines 29-37). Based thereon, the Examiner alleges that "it would have been obvious to one of ordinary skill in the art at the time the invention was made in response to a detection signal of operational irregularity in the

excitation light emitting means 111 of Hayashi as suggested by Graessle et al. to switch the image obtaining means to a standard image obtaining mode by movement of mirror 121 in Hayashi by analogy to mirror 186 in Cline et al." (Office Action, page 3).

Applicants disagree with the Examiner and respectfully submit that the aforementioned combination is suggested only by employing impermissible hindsight.

For example, Cline describes that an image obtaining portion for a fluorescent light image must be protected from bright light, *e.g.*, white light reflectance images from an endoscope eyepiece (Cline: col. 11, lines 29-37). Thus, when switching from a fluorescence imaging mode to a white light imaging mode, control center 20 immediately shuts off the power to the ICCDs and stops the display of all images until a movable mirror 186 has reached the correct position corresponding to the white light imaging mode (Cline: col. 11, lines 38-58).

These steps for protecting elements of a fluorescence camera head during changeover from a fluorescence imaging mode to a white light imaging mode do not teach or suggest the steps of "emitting the illuminating-light", "switching the image obtaining means to a standard-image obtaining mode", "obtaining the standard-image" and "displaying the standard-image" in response to a detected operational irregularity, as recited in claim 1 (*see also* claim 5).

Thus, contrary to the Examiner's allegation, neither the alarm of Graessle nor the mode change protection scheme of Cline would not have led one of ordinary skill in the art at the time of Applicants' invention to modify Hayashi in order to render the features of claims 1 and 5 obvious.

Consequently, claims 1 and 5 are patentable for at least the above exemplary reasons.

Claim 12/5

In view of the above, claim 12/5 is patentable at least by virtue of its dependency.

IV. Formal Matters

Priority

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119, including receipt of the priority document.

Drawings

Applicants thank the Examiner for indicating her acceptance of Applicants' drawings, as filed on August 2, 2001.

Specification

Applicants amend the Specification to correct a typographical error.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111

U.S. Application No. 09/919,853
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Respectfully submitted,



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